



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
US 7,014,500	07/17/97	STEVENS	511,000

ADDRESSEE: STEVEN  
PATENT 200000  
1017 14 10/10/97  
1011 102  
SANTA ANA CA 92701

(08/11/97)

EXAMINER

DATE RECD

ART UNIT

PAPER NUMBER

1001

DATE MAILED:

07/16/98

Please find below and/or attached an Office communication concerning this application or  
proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/914,536

Applicant(s)

Stevenson et al

Examiner

Erma Cameron

Group Art Unit

1762



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 3, 4, 6, 9-14, 18, 19, and 21-38 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, 5, 7, 8, 15-17, and 20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1762

## **DETAILED ACTION**

### ***Election/Restriction***

I. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to a method, classified in class 427, subclass 393.5.
- II. Claims 21-34, drawn to a pigmented composition, classified in class 524, subclass 88.
- III. Claims 35-38, drawn to an clear overcoat composition, classified in class 524, subclass 88.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group II/III and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products or compositions can be used in a materially different way, such as being extruded into free-standing sheets..

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1762

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

A)

a) applied by spray (Claims 2 and 22);

b) applied by roll or brush (Claims 3-4 and 23-24);

B)

c) where the colorant is an organic pigment and/or dye (Claims 5, 7-8, 25, 27-28);

d) where the colorant is an inorganic pigment (Claims 6, 9-14, 26, 29-34);

And within d),

C)

e) titanium dioxide (Claims 9 and 29);

f) carbon black (Claims 10 and 30);

Art Unit: 1762

- g) metallic solid (Claims 11 and 31);
- h) pearlescent (Claims 12 and 32);
- l) phosphorescent (Claims 13 and 33);
- j) fluorescent (Claims 14 and 34)

D)

- k) overcoat is lacquer (Claims 18 and 36);
- l) overcoat is emulsion (Claims 19 and 37);
- m) overcoat is polymer (Claims 20 and 38).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 21 and 35 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

Art Unit: 1762

of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Robert Strauss on March 10, 1998 a provisional election was made with traverse to prosecute the invention of Group I and species a) and c) and m), claims 1-2, 5, 7, 8, 15-17, and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 4, 6, 9-14, 18-19, and 21-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Art Unit: 1762

***Claim Rejections - 35 USC § 112***

8. Claims 1-2, 5, 7-8, 15-17 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 1: it is not clear what is meant by enhancement or enhanced. Enhanced over what?

B) Claim 1: the group of binder solids is confusing in that a) the species appears to overlap, b) petroleum appears not to be a solid and c) both synthetic and emulsifiable waxes appear to both be required.

C) Claim 1: there is no antecedent basis for deposited decorative enhancement composition or for said interfacing surface.

D) Claim 1: elevated temperature is vague.

E) Claim 5: should be put into proper Markush form.

Art Unit: 1762

F) Claim 5: there should be a comma after monoazo-based.

G) Claim 15: there is no antecedent basis for the exposed surface.

H) Claim 17: there is no antecedent basis for said enhanced surface.

9. Claims 1-2, 5, 7-8, 15-17 and 20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A) the meaning of the last two lines of the Abstract is not clear.

B) Figure 6 and 10:3-6 do not agree.

C) The Abstract reads 70 to 95 percent binder whereas the claims are to 30-70% binder.



Art Unit: 1762

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 5, 7-8, 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/23041.

'041 teaches a thermoplastic spray material for bonding to polyethylene (p4) where the composition comprises 5-95% polyethylene powder with particle size less than 50 microns (p18-19), organic or inorganic pigments or mixtures, organic solvents or water or mixtures (p19), and resin particles such as rosins or hydrocarbon resins (p21). After application to a surface, the composition is heated (p20).

The composition of '041 overlaps with applicant's claimed ranges.

The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been

Art Unit: 1762


held to be a prima facie case of obviousness. See *In re Malagari* 182 USPQ 549.

`041 does not teach a clear overcoat, but a color-plus-clear type of surface coating is conventional to the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a protective clear overcoat to the pigmented coating of `041, for protection.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is (703) 308-2330.

  
ERMA CAMERON  
PATENT EXAMINER  
GROUP 1100

Erma Cameron

September 10, 1998